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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,588	03/30/2001	S. Sean Moore	UV/192	6830
1473 7590 01/06/2009 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER LASTRA, DANIEL	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 01/06/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/823,588

Applicant(s)

MOORE ET AL.

Examiner

DANIEL LASTRA

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09/11/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-10,12-18,20-24,26-37,40-43,45-48 and 50-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-10,12-18,20-24,26-37,40-43,45-48 and 50-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 2, 6-10, 12-18, 20-24, 26-37, 40-43, 45-48 and 50-63 have been examined. Application 09/823,588 (SYSTEM AND METHOD FOR METADATA-LINKED ADVERTISEMENTS) has a filing date 03/30/2001 Claims Priority from Provisional Application 60193948, filed 03/31/2000.

Response to Amendment

2. In response to Non Final Rejection filed 04/09/2008, the Applicant filed an Request for reconsideration on 09/11/2008.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6-18, 20-24, 26-34, 37, 40-43, 45-48 and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al (U.S. 6,357,042) in view of Reilly (US 5,740,549).

As per claims 1, 18, 32, 36, 37, 43, 48 and 53-63, Srinivasan teaches:

A method executed by at least one computer processor for providing metadata-selected advertisements, comprising:

receiving at user equipment media comprising at least one object (see “CPE” or “set top box”; col 7, lines 35-50; col 12, lines 20-40; col 17, lines 63-67; col 20, lines 45-55; col 22, lines 1-35; col 29, lines 45-65; col 31, lines 1-15), metadata associated with the at least one object and containing a description of the at least one object, and metadata associated with a plurality of advertisements (see column 5, line 62 – column 6, line 19; column 6, lines 10-18 “advertisements, may for example, be associated with a tracked object”; column 32, lines 22-30);

displaying the media and the at least one object on a viewing device (see column 7, lines 37-49) at the user equipment (see col 7, lines 25-50; col 22, lines 1-35; col 30, lines 40-65);

receiving a user selection of one of the at least one object displayed on the viewing device (see column 7, lines 35-50; col 22, lines 1-10);

processing metadata associated with the object selected by the user (see col 3, lines 10-20; col 6, lines 10-20; col 12, lines 25-40; col 22, lines 1-10; column 32, line 21 – column 33, line 3). Srinivasan assigns metadata (i.e. URLs) to an entity in a video and the user click said entity in said video and receive advertisements from said clicking.

comparing at the user equipment the metadata associated with the object selected by the user with the metadata associated with the plurality of advertisements (see column 7, lines 25-50; col 12, lines 20-35; col 22, lines 1-10); and

selecting at the user equipment one of the plurality of advertisements based on the comparison (see column 7, lines 25-50; col 22, lines 1-10; col 32, lines 20-40)

monitoring the selected advertisement (see column 7, lines 35-49; column 31, line 45-56);

downloading to the user equipment the plurality of advertisements related to the media (see col 29, lines 45-65; col 31, lines 1-15; col 33, lines 1-5; col 34, lines 55-65);

monitoring the selected advertisement, collecting data on the selected advertisement (see column 7, lines 36-49), recording the data and downloading the selected advertisement and displaying the selected advertisement (see col 12, lines 20-40; column 22, lines 1-35; col 31, lines 47-64).

Srinivasan does not expressly teach that after comparing the metadata associated with the object selected by the user with the metadata associated with a plurality of advertisements, that the selecting at the user's equipment of one a plurality of advertisements based upon said comparison is performed from a plurality of advertisements that were previously received and stored at the user equipment. However, Reilly teaches a system that after a user selects an object in a media (i.e. "user clicks on said object"; see Reilly col 13, lines 30-40), Reilly compares the metadata associated with the selected object (i.e. "news item information category") with the metadata associated with a plurality of advertisements (i.e. "advertisement information category") that were previously received and stored in said user's computer, and based upon said comparison, Reilly selects to display on said user's computer one of said plurality of advertisements whose associated metadata matches the associated metadata of the selected objected (see Reilly col 13, lines 60-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was

made, to know that Srinivasan would compare the metadata of a user's selected entity in a video with the metadata of a plurality of advertisements that were previously received and stored in a said user's computer and based upon said comparison, Reilly would select to display on said user's computer, one of said plurality of advertisements whose associated metadata matches the associated metadata of said selected object, as taught by Reilly in order that Srinivasan would avoid the need to pull advertisements from a remote server (see Srinivasan col 12, lines 25-40; col 22, lines 1-10; column 32, line 21 – column 33, line 3), as said one of plurality of advertisements selected to be displayed, would had been already stored in said user's computer, as taught by Reilly.

As per claim 2, Srinivasan teaches:

displaying the selected advertisement on the viewing device (see column 12, lines 20-35; column 32, lines 21-64).

As per claims 6, 20, 40, 45 and 50, Srinivasan teaches:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 7, 21, 41, 46 and 51, Srinivasan teaches:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are received on a separate broadcast channel from the media (see column 31, lines 15-56; col 37, lines 5-67).

As per claims 8, 22, 42, 47 and 52, Srinivasan teaches:

storing the metadata associated with the at least one object and the metadata associated with the plurality of advertisements (see column 17, lines 20-25; col 32, lines 21-31; col 33, lines 1-3).

As per claims 9 and 23, Srinivasan teaches:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are stored on a single storage device (see figure 16; column 32, lines 21-31; col 34, line 55 – col 35, line 20).

As per claims 10 and 24, Srinivasan teaches:

wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are stored on a plurality of storage devices (see figure 16, column 30, lines 53-67).

As per claims 12 and 26, Srinivasan teaches:

wherein the plurality of advertisements are received within the media (see column 12, lines 20-35; column 32, lines 21-56).

As per claims 13 and 27, Srinivasan teaches:

wherein the plurality of advertisements are received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 14 and 28, Srinivasan teaches:

wherein the plurality of advertisements are received on a separate broadcast channel from the media (see column 31, lines 15-56).

As per claims 15 and 29, Srinivasan teaches:

storing the selected advertisement (see column 32, lines 21-55).

As per claims 16 and 30, Srinivasan teaches:

wherein the selected advertisement is stored on a single storage device (see figure 16, column 32, lines 21-31) .

As per claims 17 and 31, Srinivasan teaches:

wherein the selected advertisement is stored on a plurality of storage devices (see figure 16, column 32, lines 21-31).

As per claim 33, Srinivasan teaches:

wherein the metadata associated with the object and the metadata associated with the plurality of advertisements further contain at least one source address (see column 32, lines 21-40).

As per claim 34, Srinivasan teaches:

wherein at least one of the at least one source address is a Uniform Resource Locator (see column 32, lines 21-40).

As per claim 35, Srinivasan does not expressly teach:

wherein at least one source address is a telephone number. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Srinivasan would include in the source address the advertiser's telephone number therefore giving users the advertiser's contact information.

Claim 54, Srinivasan teaches:

periodically receiving the plurality of advertisements from one or more remote locations (see col 32, lines 1-5).

Claim 55, Srinivasan teaches:

receiving the plurality of advertisements from one or more remote locations in response to requests made by the user equipment (see col 32, lines 20-45).

Claim 56, Srinivasan teaches:

polling one or more remote location for the plurality of advertisements (see col 34, lines 10-25).

Claim 57, Srinivasan teaches:

storing the plurality of advertisements at the user equipment (see col 34, lines 55-67; col 33, lines 1-20).

Claim 58, Srinivasan teaches:

ordering one or more items displayed by the selected advertisement (see col 32, lines 35-40).

Claim 59, Srinivasan teaches:

wherein the at least one receiver periodically receives the plurality of advertisements from one or more remote locations (see col 32, lines 1-5).

Claim 60, Srinivasan teaches:

wherein the at least one receiver receives the plurality of advertisements from one or more remote locations in response to requests made by the processor (see col 32, lines 20-45).

Claim 61, Srinivasan teaches:

wherein the processor is configured to poll one or more remote locations for the plurality of advertisements (see col 34, lines 10-25).

Claim 62, Srinivasan teaches:

at least one storage unit for storing the plurality of advertisements at the user equipment (see col 34, lines 55-67; col 33, lines 1-20).

Claim 63, Srinivasan teaches:

wherein the processor is operative to order one or more items displayed by the selected advertisement (see col 32, lines 32-40).

Response to Arguments

4. Applicant's arguments filed 09/11/2008 have been fully considered but they are not persuasive. The Applicant argues that the prior art does not teach receiving at user equipment, metadata that contains a description of the media or at least one object in the media. The Examiner answers that Srinivasan teaches adding metadata to a media or to a specific image entity in said media, such as text, logos for advertisements, some of which may be associated with identity and address data to allow a viewer at a computerized end station to access advertisements and other data which may be associated with individual entities in the video presentation (see col 6, lines 7-18). Furthermore, Srinivasan teaches transmitting said metadata as annotated data to a end user equipment (see col 7, lines 40-50; col 13, lines 50-53 "CPE"). Therefore, contrary to Applicant's argument, Srinivasan teaches Applicant's claimed invention.

The Applicant argues that the references cannot be combined because according to the Applicant, in Srinivasan, even when the primary video and advertisements are delivered by different networks, the integration, according to the Applicant, is still orchestrated by ad server. The Applicant further argues, that the prior arts are not combinable because Srinivasan requires that ads be stored on a server with

an ad server serving as the controlling entity that integrates and coordinates the ads, while Reilly, according to the Applicant, requires that ads be stored locally at a work station. The Examiner answers that Srinivasan teaches combining and synchronizing the video data, annotated data and video ads at the end user equipment (i.e. set top box) (see col 31, lines 5-15). Therefore, contrary to Applicant's argument, in Srinivasan the integration is not necessarily performed and controlled in an ad server and therefore, contrary to Applicant's argument, the prior arts are combinable.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

/DANIEL LASTRA/
Examiner, Art Unit 3688
December 24, 2008